

## **REMARKS**

This is a full and timely response to the outstanding non-final Office Action mailed September 22, 2004. Upon entry of the amendments in this response, claims 1 – 21 remain pending. In particular, Applicant amends claims 1, 10, 15 – 17, and 19 – 21 and cancels claim 8 without prejudice, waiver, or disclaimer. Applicant cancels claim 8 merely to reduce the number of disputed issues and to facilitate early allowance and issuance of other claims in the present application. Applicant reserves the right to pursue the subject matter of this canceled claim in a continuing application, if Applicant so chooses, and does not intend to dedicate the canceled subject matter to the public. Reconsideration and allowance of the application and presently pending claims are respectfully requested. In addition, Applicant does not intend to make any admissions regarding any other statements in the Office Action that are not explicitly referenced in this response.

### **I. Indication of Allowable Subject Matter**

The Office Action indicates that claim 15 is objected to as being dependent upon rejected base claims, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant appreciates the Office Action's indication of allowable subject matter, and amends claim 15 to incorporate all the limitations of the base claims. Applicant submits that claim 15, as amended is in condition for allowance.

## **II. Rejections Under 35 U.S.C. §102**

A proper rejection of a claim under 35 U.S.C. §102 requires that a single prior art reference disclose each element of the claim. *See, e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983).

### **A. Claim 1 is Patentable Over Crosby, et al.**

The Office Action indicates that claims 1 – 4, 7 – 14, 16, 20, and 21 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. patent number 5,933,192 to Crosby, et al. (“Crosby”). Applicant amends claim 1 to further illustrate the novel features of claim 1 over Crosby. More specifically, claim 1, as amended recites a “system... comprising... a prediction evaluator, configured to determine if said television channel predicted by said look-ahead tuning logic matches a subsequent subscriber requested television channel, wherein the prediction evaluator is further configured to adjust said look-ahead tuning logic to effect more accurate channel predictions in the future, based on the accuracy of past channel predictions.”

The Office Action recites that “Crosby discloses a prediction evaluator to determine if the predicted next channel was correct or wrong (see col. 6 lines 50 – 56)” (OA, p. 3, lines 20 – 21). Applicant respectfully disagrees with this analysis. Claim 1, as amended recites “... a prediction evaluator, wherein said prediction evaluator determines if said television channel predicted by said look-ahead tuning logic matches a subsequent subscriber requested television channel, wherein the prediction evaluator is further configured to adjust said look-ahead tuning logic to effect more accurate channel predictions in the future, based on the accuracy of past channel predictions.” However, Crosby recites that “improved channel-change response is available only if a user selects the predicted next channel; that is, if the microcontroller was ‘correct’ in

predicting the next channel. However, even if the user selects a new channel that is not the predicted new channel (i.e., the prediction was ‘wrong’), the channel change can still be completed as quickly as in the conventional receiver” (col. 6, lines 50 – 56). This illustrates that *Crosby* does not contemplate a “prediction evaluator.” For at least this reason, Applicant submits that claim 1, as amended is patentable over *Crosby*.

**B. Claim 9 is Patentable over *Crosby et al.***

The Office Action indicates that claims 1 – 4, 7 – 14, 16, 20, and 21 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. patent number 5,933,192 to Crosby, et al. (“*Crosby*”). More specifically, the Office Action recites that “Crosby inherently discloses the claimed look-ahead tuning logic compris[ing] a feed back loop since the[re] are first selected, and that the predicted look-ahead tuning is based on channels previously selected (see col. 5, lines 13 – 25)” (p. 4, lines 4 – 6). However, claim 9 recites “[t]he digital set-top box of claim 1, wherein said look-ahead tuning logic comprises a feedback loop.”

It is well established that “[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration.” *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983). Additionally, “[t]o establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In Re Anthony J. Robertson*, 98-1270 (Fed. Cir. 1999).

Applicant respectfully submits that the cited reference does not disclose each and every element of claim 1. In accordance with *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2D (BNA) 1949, 1950-51 (Fed. Cir. 1999), Applicant traverses the finding that *Crosby* inherently discloses look-ahead tuning logic “wherein said look-ahead tuning logic comprises a feedback loop” as being inadequate to show why all of the claim elements are “inherently present” in the reference.

**C. Claim 10 is Patentable Over *Crosby, et al.***

The Office Action indicates that claims 1 – 4, 7 – 14, 16, 20, and 21 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. patent number 5,933,192 to Crosby, et al. (“*Crosby*”). Applicant amends claim 10 to further illustrate the novel features of claim 10 over *Crosby*. More specifically, claim 10, as amended recites a “method... comprising... determining if said predicted next television channel matches a subsequent subscriber requested television channel; and automatically adjusting future channel predictions based on the accuracy of past channel predictions.”

The Office Action recites that “*Crosby* discloses a prediction evaluator to determine if the predicted next channel was correct or wrong (see col. 6 lines 50 – 56)” (OA, p. 3, lines 20 – 21). Applicant respectfully disagrees with this analysis. Claim 10, as amended recites “...determining if said predicted next television channel matches a subsequent subscriber requested television channel; and automatically adjusting future channel predictions based on the accuracy of past channel predictions.” However, *Crosby* recites that “improved channel-change response is available only if a user selects the predicted next channel; that is, if the microcontroller was ‘correct’ in predicting the next channel. However, even if the user selects a new channel that is

not the predicted new channel (i.e., the prediction was ‘wrong’), the channel change can still be completed as quickly as in the conventional receiver” (col. 6, lines 50 – 56). This illustrates that *Crosby* does not contemplate a “determining if said predicted next television channel matches a subsequent subscriber requested television channel.” For at least this reason, Applicant submits that claim 10, as amended is patentable over *Crosby*.

**B. Claims 2 – 4, 7, 9, 11 – 14, 16, and 20 - 21 are Patentable Over *Crosby et al.***

In addition, dependent claims 2 – 4, 7, and 9 are believed to be allowable for at least the reason that these claims depend from allowable independent claim 1. Further, dependent claims 11 – 14 are believed to be allowable for at least the reason that they depend from allowable independent claim 10. Finally, dependent claims 16 and 20 – 21 are believed to be allowable for at least the reason that these claims depend from allowable independent claim 15. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

**III. Rejections Under 35 U.S.C. §103**

In order for a claim to be properly rejected under 35 U.S.C. §103, the teachings of the prior art reference must suggest all features of the claimed invention to one of ordinary skill in the art. *See, e.g., In re Dow Chemical*, 837 F.2d 469, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 642 F.2d 413, 208 U.S.P.Q. 871, 881 (C.C.P.A. 1981). Further, “[t]he PTO has the burden under section 103 to establish a prima facie case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

**A. Claims 6 is Patentable Over Crosby in View of Reitmeier**

The Office Action indicates that claims 5, 6, 17, 18, and 19 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Crosby in view of U.S. patent number 6,118,498 to Reitmeier ("*Reitmeier*"). Applicant respectfully traverses this rejection for at least the reason that the *Crosby* in view of *Reitmeier* fails to disclose, teach, or suggest all of the elements of claim 6.

More specifically, the Office Action recites that "Crosby discloses a microcontroller 70 which weighs the probably next television channel predicted by the user. It is inherent that the ordering is done in some kind of memory or 'database'" (OA, p. 6, lines 13 – 15). However claim 6 recites "[t]he digital set-top box of claim 2, further comprising a weighting database, wherein said weighting database orders said television channels to generate said list of television channels."

It is well established that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983). Additionally, "[t]o establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In Re Anthony J. Robertson*, 98-1270 (Fed. Cir. 1999).

Applicant respectfully submits that the cited reference does not disclose each and every element of claim 1. In accordance with *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2D (BNA) 1949, 1950-51 (Fed. Cir. 1999), Applicant traverses the finding that *Crosby* "inherently

discloses that the ordering is done in some kind of memory or ‘database’” as being inadequate to show why all of the claim elements are “inherently present” in the reference. Consequently, for at least this reason, the Office Action’s statement regarding claim 6 is merely conclusory and unsupported, and the rejection should be withdrawn.

**B. Claims 5, 6, and 17 – 19 are Patentable Over Crosby, in View of Reitmeier**

In addition, dependent claims 5 and 6 are believed to be allowable for at least the reason that these claims depend from allowable independent claim 1. Further, dependent claims 17 – 19 are believed to be allowable for at least the reason that they depend from allowable independent claim 15. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

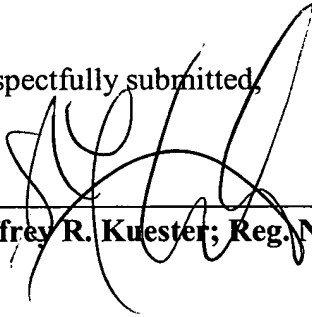
**IV. Cited Art Made of Record**

The cited art made of record has been considered, but is not believed to affect the patentability of the presently pending claims.

## CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 1 - 21 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



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